

**AMENDMENTS TO THE DRAWINGS**

The attached sheets of drawings include changes to Fig. 1 and a new Fig. 5. The changes to Fig. 1 are illustrated by the annotations in the attached Annotated Sheet. It is respectfully submitted that neither the changes to Fig. 1, nor the new Fig. 5, adds any new matter to the application.

Attachment:        Replacement Sheet  
                         Annotated Sheet showing changes

### **REMARKS**

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-42 are pending in the present application. Claims 1, 9, 15, 17-21, 28, 30, and 31 have been amended. Claims 35-42 are new. Claims 1, 15, 17, 18, 21, 28, and 31 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and following remarks.

#### ***Claim for Priority***

The Examiner has not recognized Applicants' claim for foreign priority. In view of the fact that the Applicants' claim for foreign priority has been perfected, the Examiner is respectfully requested to acknowledge the claim for foreign priority in the next Office Action.

#### ***Drawings***

The Examiner objected to Fig. 1 because the term "PRINTINT" in element 150 is misspelled. Attached hereto is a drawing correction to Fig. 1 in which the aforementioned term has been replaced with --PRINTING--.

The Examiner objects to the drawings because they should show the steps corresponding to the program instructions in claims 18-20. The Examiner also asserts that the drawings should show the steps required in claims 21-27. Accordingly, attached hereto is new Fig. 5, which includes a flowchart illustrating such steps. Applicants further submit that the filing of new Fig. 5 does not add any new matter to the application.

The Examiner further objects to drawings because certain labels<sup>1</sup> do not correspond exactly to claimed terms. Applicants respectfully submit that the Examiner has no basis, statutory or otherwise, to require the drawing labels to use the exact language recited in the claims. As set forth in 35 U.S.C. § 113 and 37 C.F.R. § 1.81, the purpose of the drawings is to

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<sup>1</sup> Particularly, the Examiner objects to the following labels: DELIVERY-MEDIUM RECORDING APPARATUS and IMAGE RECEIVING UNIT.

facilitate understanding of the subject matter to be patented. Applicants respectfully submit that the drawings, with their present labels, facilitate understanding of the claimed invention. Thus, withdrawal of this objection is respectfully requested.

The Examiner further objects to the drawings because it is unclear whether the CONVERTED IMAGE KEEPING UNIT in Fig. 1 is the “another receiving unit” recited in claim 2. Applicants respectfully submit that the drawings and accompanying written description in the specification are clearly enabling and sufficient for proper understanding for the claimed “another receiving unit.” For example, page 13, lines 19-23 states,

The converted image keeping processing unit 80 receives a negative film 130... The converted image keeping-processing unit sends the received negative film to the image converting unit 70.

Such description, in conjunction with the illustration in Fig. 1, clearly enables the claimed “another receiving unit operable to receive a negative film,” regardless of whether this “another receiving unit” is to be implemented as part of the converted image keeping unit 80 or as another unit operably connected to the converted image-keeping unit 80. Thus, Applicants respectfully submit that this objection to the drawings is improper and should be withdrawn.

### *Specification*

The Examiner objected to the title indicating that a new title is required that is clearly indicative of the invention to which the claims are directed. Accordingly, Applicants have replaced the title with “APPARATUSES AND METHODS FOR USE IN PRODUCTION AND DELIVERY OF A MEDIUM ON WHICH IMAGES ARE RECORDED.” It is respectfully submitted that the new title is clearly indicative of the claimed invention. As such, withdrawal of this objection is requested.

The Examiner objected to page 9, line 5, because the term “CD-R, MO or the like” is allegedly misspelled. Applicants respectfully disagree. This portion of the specification is referring to different types of discs: CD readable (CD-R) discs, Magneto Optic (MO) discs, or

the like. Since line 5 of page 9 does not contain a spelling error, no amendment is necessary. Thus, reconsideration and withdrawal of this objection is requested.

The Examiner also objected to the following sections of the specification as requiring rewording: page 11, lines 8-11; and page 14, lines 13-16. Applicants respectfully submit that clarifying amendments have been made to these sections. Accordingly, the Examiner is requested to withdraw these objections.

### *Claim Objections*

The Examiner objected to claims 1-17 because the Examiner believes that the claimed invention is a system, rather than a method. Thus, the examiner suggests changing the first line of each of these claims from "A delivery-medium producing apparatus" to --A delivery-medium producing system--. Initially, Applicants respectfully point out that the Examiner does not have authority (statutory or otherwise), nor does the Examiner assert he has such authority, to require such an amendment. Further, Applicants respectfully refer the Examiner to 35 U.S.C. § 112, second paragraph, which states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which *the applicant* regards as his invention.

(Emphasis added.) Accordingly, claims 1-17 are to recite what *Applicants* regard as the invention, rather than the Examiner. Since Applicants regard their invention as an apparatus, rather than a system, Applicants respectfully submit that the Examiner's suggested amendment to claims 1-17 is not necessary. Thus, the Examiner is respectfully requested to reconsider and withdraw this objection.

The Examiner objects to claim 9 (last line), suggesting that "number" be changed to --quantity--. The Examiner's suggested amendment has been implemented above. Thus, this objection should be withdrawn.

The Examiner objected to claim 22 (line 3), suggesting that “said capturing unit” should be changed to --said capturing device--. However, Applicants point out that line 3 of claim 22 is referring to the “capturing unit” in independent claim 21 (line 2). As such, the Examiner’s suggested amendment would not be appropriate and, thus, has not been implemented. Reconsideration and withdrawal of this objection is respectfully requested.

The Examiner also objected to claim 30 (last line) because “said keeping” should be changed to --said image keeping apparatus--. The Examiner’s suggested amendment has been implemented above. Thus, this objection should be withdrawn.

***Rejection Under 35 U.S.C. § 102***

**Fredlund**

Claims 1, 2, 4-14, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,666,215 to Fredlund et al. (hereafter “Fredlund”). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, Applicants point out that the Examiner has failed to establish a *prima facie* case of anticipation as to claim 30 with regard to Fredlund. Particularly, claim 30 is dependent on independent claim 28 and, accordingly, incorporates the features in claim 28. Since the Examiner does not assert that Fredlund discloses all the features in claim 28<sup>2</sup>, it is respectfully submitted that this rejection of claim 30 is improper.

As amended, independent claim 1 now recites a delivery-medium producing apparatus that performs the following: receives a plurality of images *automatically* in accordance with an instruction determined by the user(s) in advance, and records the automatically received images onto recording media. Fredlund fails to teach or suggest such an apparatus.

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<sup>2</sup> Instead, the Examiner rejected claim 28 under 35 U.S.C. § 103 as being unpatentable over Fredlund in view of Allen and Jackson.

In the rejection that the Examiner relies on the operation of Fredlund's CD writer 113 to perform the claimed recording of images onto recording media (see Office Action at 5). However, Fredlund requires the user to select which of the images which are to be stored on the CD. See, e.g., col. 5, lines 32-51.

Accordingly, Fredlund fails to disclose each and every feature of independent claim 1. As such, Applicants respectfully submit that claim 1 is allowable, and claims 2 and 4-14 are allowable at least by virtue of their dependency on claim 1. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **Jackson**

Claims 15-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,760,128 to Jackson et al. (hereafter "Jackson").

However, Applicants respectfully point out that Jackson does *not* constitute prior art under § 102(b) because it was not patented more than one year prior to the filing date of the present application (June 28, 2001). Furthermore, Applicants point out that the present application claims priority under 35 U.S.C. § 119 to Japanese Application No. 2000-194836, which was filed on June 28, 2000. Thus, the effective priority date of the present application is June 28, 2000, which is *before* the filing date of Jackson (December 6, 2000). Attached hereto is a certified English translation of JP 2000-194836 upon which the present application claims priority. Accordingly, Jackson is *disqualified* as prior art under *any* provision of § 102.

Since Jackson is disqualified as prior art, Applicants respectfully submit that the rejection of claim 15-17 is improper. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

**Allen**

Claims 18-22, 25-27, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,737,491 to Allen et al. (hereafter "Allen"). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, Applicants again wish to point out that this rejection of claim 30 is improper. Specifically, claim 30 is dependent upon independent claim 28 and, thus, incorporates the features of claim 28. Since claim 28 is not rejected under § 102 as being anticipated by Allen, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation as to claim 30.

As amended, independent claims 18 and 21 recite a digital camera and capturing device, respectively, which *automatically* transmit each of a plurality of captured images to an external apparatus in accordance with an instruction determined by a user in advance.

Conversely, Allen teaches a camera that requires the user to issue a verbal command to select the captured images to be uploaded, before such images are sent to the external device (i.e., image fulfillment server). See, e.g., Fig. 2 and col. 4, lines 36-54. Thus, Allen's camera does not *automatically* send the captured images to an external device in accordance with an instruction determined in advance, as claimed. Instead, Allen requires user intervention to send the captured images.

Applicants respectfully submit that independent claims 18 and 21 are allowable at least for the reasons set forth above. Accordingly, claims 19, 20, 22, and 25-27 are allowable at least by virtue of their dependency on claims 18 and 21. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

*Rejections Under 35 U.S.C. § 103*

**Fredlund/Komatsu**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fredlund in view of U.S. Patent No. 4,817,050 to Komatsu et al. (hereafter "Komatsu"). Applicants respectfully submit that Komatsu fails to remedy the deficiencies of Fredlund as set forth above in connection with independent claim 1. Particularly, the Examiner only relies on Komatsu to teach "a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses," which does not remedy the deficiencies of Fredlund. Thus, Applicants submit that claim 3 is allowable at least by virtue of its dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

**Allen/Komatsu**

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Komatsu. It is respectfully submitted that Komatsu fails to remedy the deficiencies of Allen set forth above in connection with independent claim 21. Particularly, the Examiner only relies on Komatsu to teach "a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses." Since this teaching does not remedy Allen's deficiencies with respect to claim 21, Applicants respectfully submit that claims 23 and 24 are allowable at least by virtue of their dependency on claim 21. Accordingly, Applicants request the Examiner to reconsider and withdraw this rejection.

**Fredlund/Allen/Komatsu**

Claims 28, 29, and 31-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fredlund, Allen, and Jackson. However, since Jackson is disqualified as prior art, Applicants respectfully submit this rejection is improper and should be withdrawn.

***No Prosecution History Estoppel***

According to the above amendments, claims 15, 17, and 31 are presented in independent form. Since the subject matter of these claims has not been changed due to such amendments, no prosecution history estoppel should apply to the interpretation of the limitations set forth in independent claims 15, 17, and 31.

***Conclusion***

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,



By

  
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Attachments:

Certified English Translation of JP 2000-194836

Drawings: Figures 1 and 5